

Application No. 09/988,659
Response to March 25, 2005, Action

Attorney's Docket No. 0119-071

REMARKS

Claims 1-33 are pending.

In the pending Office Action, claims 9 and 19 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness because they relate to "offline" transmission of information from a client to a service provider ("SP"). Such operation is described in the application, for example, at p. 11, ll. 19-21, and uses the word "offline" in its well-understood sense of non-contemporaneous. See, e.g., Denis Howe, *The Free On-line Dictionary of Computing*, 1993-2005, which defines "off-line" or "offline" as follows:

2. Not now or not here. "Let's take this discussion off-line." Specifically used on Usenet to suggest that a discussion be moved off a public newsgroup to e-mail.

In view of these uses of the word, it is submitted that the rejected claims meet the requirements of Section 112, which after all requires only that the claims be reasonably clear to the artisan. As explained in Section 2173.02 of the MPEP:

Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

If the Examiner continues to assert that claims 9 and 19 are indefinite, he is respectfully requested to suggest claim language having improved clarity.

Claims 1-6, 8-10, and 12-33 stand rejected under 35 U.S.C. § 102(e) for anticipation by U.S. Patent No. 6,119,045 to Giniger et al. ("Giniger"), and claims 7, 11, and 30 stand rejected under 35 U.S.C. § 103(a) for obviousness over a combination of Giniger and B. Schneier, Applied Cryptography, 1996, John Wiley & Sons, Inc., pp. 47-54, 185-187 ("Schneier").

These rejections should be reconsidered and withdrawn because neither Giniger nor the combination of Giniger and Schneier teaches or even suggests all of the features recited in the claims, and thus Giniger and Schneier are insufficient as bases for either anticipation or a *prima facie* case of obviousness.

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The claims generally relate to location-based services from third party service providers ("SPs"). A problem with such services is noted in the application on page 1, at lines 25-29: "location dependent services present concerns relating to the privacy rights of subscribers. Many subscribers are reluctant to have their location monitored to avoid breaches of privacy from various governmental agencies, commercial entities, or even from personal acquaintances."

Accordingly, claim 1, for example, defines a method for initiating a location-based service from an SP that includes, in pertinent part, transmitting encrypted identification information from the client to the SP, and launching a location request from the SP to the network location server ("NLS"), the location request including the encrypted identification information received from the client. The underlining highlights the fact that encrypted information passes from the client to the SP and from the SP to the NLS. Independent claims 12 and 24 have recitations similar to these portions of claim 1. Privacy is also ensured by the network entity defined by independent claim 21 that provides a requested location of a mobile client to an SP without identifying the mobile client. Privacy is also ensured by the mobile client defined by independent claim 27 that provides encrypted client identification information with a request to an SP.

The pending Action asserts in the portion of paragraph 6 bridging pages 3 and 4 that Giniger teaches "Launching a location request from the SP to the NLS the location request including the encrypted identification information received from the client / Remote Access Server - Security Element - Server (Fig 8, Elements 801, 802, 805, '045)" and citing col. 15, l. 3, that networks use a request response communication structure. This assertion is not completely understood.

It is noted that Giniger's Remote Access Server 801, Security Element 802, and Server 805 are depicted in FIG. 8 as a Central Site Server 107', and therefore any communications between the elements 801, 802, 805 simply occur within a single entity, not between a third-party SP and an NLS as claimed. The pending Action admits this at the beginning of paragraph 6, in characterizing the Central Site Server as the NLS feature of the claims. Accordingly, communications within Giniger's Central Site Server say nothing about communications between a third-party SP and an NLS that include encrypted identification information received from a client as claimed.

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Even if it is granted for the sake of argument that communications between Giniger's elements 801, 802, 805 can be characterized as occurring between an NLS and a third-party SP, Giniger does not describe launching a location request from the SP to the NLS that includes encrypted identification information received from a client. At col. 20, ll. 16-37, Giniger describes the operation of its security element 802 in very general terms as having a secure mode and a pass-through mode that are selectable by the user. From the generality of the description, it is submitted that Giniger simply does not describe launching a location request from the third-party SP to the NLS that includes encrypted identification information received from a client or providing either a requested location of a mobile client to an SP without identifying the mobile client or encrypted client identification information with a request to an SP. Accordingly, Giniger fails to anticipate any of the pending claims, and it is respectfully requested that the anticipation rejections be reconsidered and withdrawn.

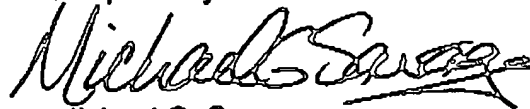
The features described above that are absent from Giniger are not supplied by Schneter, as admitted in the pending Action. Accordingly, the cited documents fail to support a *prima facie* case of obviousness, which requires, among other things, disclosure of all of the features claimed, and thus it is respectfully requested that the obviousness rejections be reconsidered and withdrawn. In view of these remarks, it is believed unnecessary to discuss in detail the other two requirements of a *prima facie* case, motivation to combine and reasonable expectation of successful combination, except to state that these would also have been lacking from the cited documents.

It is respectfully submitted that this application is now in condition for allowance, and an early Notice to this effect is respectfully solicited. If the Examiner has any questions, the undersigned attorney may be telephoned at the number given below.

The Office's attention is drawn to the Power of Attorney to Prosecute Applications and Change of Correspondence Address that were filed on March 11, 2005.

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Respectfully submitted,


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